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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------|-------------|-----------------------|---------------------|------------------|
| 10/598,669        | 06/19/2007  | Christophe Boussebart | 3712036-00751       | 8693             |
| 29157             | 7590        | 02/16/2012            | EXAMINER            |                  |
| K&L Gates LLP     |             |                       | SMITH, PRESTON      |                  |
| P.O. Box 1135     |             |                       |                     |                  |
| CHICAGO, IL 60690 |             |                       | ART UNIT            | PAPER NUMBER     |
|                   |             |                       | 1782                |                  |
|                   |             |                       | NOTIFICATION DATE   | DELIVERY MODE    |
|                   |             |                       | 02/16/2012          | ELECTRONIC       |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/598,669 | <b>Applicant(s)</b><br>BOUSSEMART ET AL. |  |
|                              | <b>Examiner</b><br>PRESTON SMITH     | <b>Art Unit</b><br>1782                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) ☒ Claim(s) 1-10 and 26-31 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-10 and 26-31 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-7 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Viennese NPL in view of Stephen Frankel, US-Patent 6,283,625 and Shlomo Greenwald, US-PGPub 2002/0130137.**

**Regarding claims 1 and 26,** Viennese NPL teaches a recipe for making hot Viennese melting chocolate in a sauce pan, stirring in light cream, slowly adding coffee, and beating until frothy. "Stirring" is considered to be the 1st predetermined speed and "beating" is considered to be the second predetermined speed since "beating" is faster than "stirring". The froth or foam is formed at the second "predetermined speed".

Viennese NPL fails to teach heating while stirring and the automated apparatus that is capable of performing manual process of Viennese with the claimed features. Viennese NPL also fails to teach the composition comprising milk.

Frankel teaches an electronic device with a "frame", "support", "container", and heating element (abstract, Fig 1, paddles can be seen at 466) capable of operating at different speeds and frothing beverages (column 11, lines 35-67). It would have been obvious to one of ordinary skill to use such a device as the one in Frankel to carry out the manual process of Viennese since machines are more favorable than manually carrying out a process since machines eliminate the need for physical exertion and save time. Additionally, it has been held that providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art.

Referring to a command and control means arrange for automatically controlling heating and "driving", controls that automatically control mixing and temperature are well known in the art and further, Greenwald teaches that control systems that automatically regulate temperature and stirring for beverage systems are well known in the art (see 0075 and 0076.) It would have been obvious to one of ordinary skill to further combine this feature with the invention of Viennese in view of Guenou since this would eliminate the need for one of ordinary skill to constantly regulate these features and make producing beverages easier.

Referring to heating while stirring, it would however have been obvious to heat while stirring since the overall beverage is desired to be hot and heating throughout the

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entire process would help maintain the beverage composition in a heated state.

Additionally, heating while carrying out the processing steps would ensure that the melted chocolate doesn't solidify at a later stage and would make it easier to mix the components such as cream and chocolate since these components mix easier in a heated state.

Referring to a composition comprising milk, the NPL reference uses melted chocolate however does not describe what the chocolate is. Most chocolates contain milk and milk chocolate is a very desirable chocolate due to its taste, texture, etc. Milk chocolate is commonly added to all kinds of beverages including coffees (for example, Starbucks commonly adds milk chocolate ingredients into coffee that is commonly prepared for consumers such as mochas). It would have for one of ordinary skill to use a common chocolate such as milk chocolate as the specific chocolate since milk chocolate is tasty and has highly desirable properties. Thus the limitation of a composition comprising milk would have been obvious.

**Regarding claim 2**, when the heating is set on a particular setting, the temperature of a liquid inside of the container will be "maintained".

**Regarding claims 3-4**, it would have been obvious to adjust heating setting and adjust the amount of heat supplied or the time of heating in response to the amount of liquid added since less heating will be required for less liquid and more heating would be required for more liquid to reach a desired temperature.

**Regarding claims 5 and 7**, the references teach the invention of claim 1 however the references fail to further teach discontinuous stirring. Frankel teaches stirring wherein the impellers reverse direction after 10-40 seconds (or 0.025-0.1 Hz) (see column 5, lines 60 - 67 and column 6, lines 1-10). It would have been obvious to carry out stirring in a similar manner with the composite invention discussed previously since this would reduce the build up of ingredients at the sides of the container due to centrifugal force and would reduce the probability of the contents coming out the side of the bowl.

**Regarding claim 6**, in the modification of the stirring of the composite invention further in view of Frankel, one of ordinary skill would have found applicant's claimed range obvious and discoverable through routine experimentation in light of the references. The effect of centrifugal force would be related to the viscosity of the beverage and the distribution of the materials in the beverage and from physical observation, one of ordinary skill would be able to determine the time it takes for the substances to accumulate on the sides of the bowl and would thus know to adjust the frequency in response.

**Claims 8-10 and 27-31 rejected under 35 U.S.C. 103(a) as being unpatentable over Viennese NPL in view of Shlomo Greenwald, US-PGPub**

**2002/0130137, Stephen W. Frankel, US-Patent 6,283,625, Merle S. Brown, US-Patent 4,537,332, and Bruce, Langer, US-Patent 5,374,444.**

**Regarding claims 8-10**, the references teach the invention of claim 1 however the speeds at the different stages are not known.

Brown teaches that whipping (or beating) beverages is commonly performed at 4000 rpm or more in the art (column 2, line 14). Langer teaches that stirring beverages is commonly done at 200-1000 rpm (column 14, line 3). It would have been obvious to one of ordinary skill to look to these references for common mixing and beating speeds to carry out the composite invention.

**Regarding claims 27-31**, these limitations would have been obvious for reasons mentioned previously.

### ***Response to Arguments***

Applicant's arguments filed 10/10/2011 have been fully considered but they are not persuasive.

Applicant argues that Viennese fails to disclose mechanically stirring at the speeds and foaming milk is different from beating a cream (page 15, 2<sup>nd</sup> paragraph). Frankel has been used to teach the concept of mechanically stirring. The claims require stirring a liquid comprising milk wherein a foam is generated. Viennese teaches this concept. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Arguments drawn to Guenou are moot since this reference has been withdrawn.

Applicant argues that Greenwald does not disclose heating the liquid to a predetermined temperature (page 16, 2<sup>nd</sup> paragraph). Greenwald was not used to teach this concept but rather Viennese was used to teach this concept. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant also argues on the page 17, 2<sup>nd</sup> paragraph that Greenwald is not configured to stir and heat according to claim 1. Greenwald teaches that control systems that automatically regulate temperature and stirring for beverage systems are well known in the art (see 0075 and 0076.) It would have been obvious to one of ordinary skill to further combine this feature with the invention of Viennese in view of Guenou since this would eliminate the need for one of ordinary skill to constantly regulate these features and make producing beverages easier.

Applicant argues that one of ordinary skill would have no reason to modify the reference in the absence of hindsight (page 18, 3<sup>rd</sup> paragraph). It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which



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was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant makes several arguments against the references individually for lacking features they were not meant to stand alone addressing. (see pages 19-23.) One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that examiner used hindsight to piece together the references to arrive at the claimed invention (see page 23). It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRESTON SMITH whose telephone number is (571)270-7084. The examiner can normally be reached on Mon-Th 6:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

prs

/Drew E Becker/

Primary Examiner, Art Unit 1782